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K-C 16,436
PATENT

Art/3625
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of David Kaufman et al.

Art Unit 3625

Serial No. 10/039,076

Filed December 31, 2001

Confirmation No. 9166

For SYSTEM AND METHOD FOR PROVIDING ABSORBENT PAPER PRODUCTS

HAVING CONSUMER-SPECIFIED FEATURES

Examiner Robert E. Rhode, Jr.

RECEIVED

JUL 26 2004

July 19, 2004

GROUP 3600

NOTICE OF FILING BRIEF ON APPEAL FROM THE EXAMINER
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

TO THE COMMISSIONER FOR PATENTS,

SIR:

- * Appellant hereby files in triplicate a Brief on Appeal to the Board of Patent Appeals and Interferences. This appeal is from the Examiner's decision mailed January 29, 2004, finally rejecting the claims. A Notice of Appeal was filed on May 19, 2004.
- * The brief fee of \$330.00 is enclosed. If there are any additional charges in this matter, please charge our Deposit Account No. 19-1345.

Respectfully submitted,

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BRIEF FOR APPELLANTS

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Chisum on Patents Chapter 1, § 1.03	11
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References

West Group, Manual of Patent Examining Procedure, 8th Ed. (2003).

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Examiner Robert E. Rhode, Jr.

BRIEF FOR APPELLANTS

This is an appeal from the final rejection of the claims of the above-identified application made in the Office action mailed January 29, 2004 and the Advisory Action mailed April 20, 2004. A Notice of Appeal was filed in the Patent Office on May 19, 2004.

I. Real Party in Interest

The real party in interest in the present appeal is Kimberly-Clark Worldwide, Inc. of 401 North Lake Street, P.O. Box 349, Neenah, Wisconsin 54957-0349, a corporation of the State of Delaware, owner of a 100 percent interest in the pending application.

II. Related Appeals and Interferences

Appellants, appellants' legal representative and the assignee are unaware of any other appeals or interferences which would directly affect, which would be directly affected by, or which would have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-23, 28-32, 34-38 and 40 have been cancelled and are not part of the appeal. Claims 24-27, 33, 39 and 41-48 are pending in the application. The rejection of claims 24-27, 33, 39 and 41-48 is appealed. Copies of the claims being appealed are attached hereto as Appendix A.

Claims 24-27, 33, 39, 41, 42 and 44-48 stand rejected under 35 U.S.C. § 103(a) as being obvious over Direct Marketing¹ in view of Froseth² and Schilling³ because the Examiner alleges that the combination of the three cited references teaches "a method in which a manufacturer produces a plurality of custom tissues within a custom package for a consumer."

Claims 43 stands rejected under 35 U.S.C. § 103(a) as being obvious over Direct Marketing in view of Froseth, further in view of Schilling and further in view of Wilmott⁴ because the Examiner alleges that the combination of the four cited references teaches a method in which a manufacturer produces a plurality of custom tissues including a fragrance within a custom package for a consumer.

IV. Status of Amendments

No amendments after final pursuant to 37 C.F.R. §1.116 were filed.

V. Summary of Invention

The following summary is in accordance with M.P.E.P. §1206 and correlates claim elements to specific embodiments described in the application specification. Consistent with M.P.E.P. §1206, the following summary does not in any manner whatsoever limit claim interpretation. Rather, the following summary is to facilitate the Board's understanding of the subject matter of the claims on appeal.

The systems and methods of the presented invention generally relate to providing consumers absorbent paper products having features selected or otherwise specified by the consumer. Absorbent paper products, such as facial tissue and paper towel products, are commonly provided with a variety of aesthetic and functional features. These features include

¹ Rosenspan, Alan, "Who Wants to Market a Millionaire?", Direct Marketing, March 2001, page 45.

² U.S. Pat. App. Pub. 2002/0004749 A1.

³ U.S. Pat. App. Pub. 2003/0035138 A1.

colors, scents, quantities, packaging styles, and may also include floral or other graphic designs on the absorbent paper products or the packaging therefor. In general, however, these features are available in only a limited number of pre-selected combinations. Thus, while a wide variety of aesthetic and functional features exist, a consumer must still choose from a relatively limited number of pre-selected feature combinations, and select a particular absorbent paper product whose combination of features most closely matches the consumer's preferences or needs. The present invention addresses this problem.

Briefly, an aspect of the invention is a method for producing a custom tissue product 600 for a consumer. (Spec. ¶ 30, Fig. 6, Claim 24). Information is received from the consumer over a communications network 602. This information defines to one or more optional features of the custom tissue product and its packaging so that the consumer can bring together a graphic design of the tissues and a package design which are independent of each other. The method also includes providing the received information to a production machine 604, and producing the custom tissue product and its packaging 606 in accordance with the information received from the consumer and provided to the production machine.

According to another aspect of the invention, one embodiment is directed to a method of providing a consumer with an absorbent paper product 100. (Spec. ¶19, Fig. 1A, Claim 33). This method provides the consumer with a first list of options for a first feature 102 of the absorbent paper product and a second list of options for a second feature 102 of the absorbent paper product via a communication network. (Spec. ¶¶20,21, Fig. 1A). The consumer selects one of the options from the first list 104 and of one of the options from the second list 104. (Spec. ¶22, Fig. 1A). Next, a purchase order for the absorbent paper product 104 is received and the custom product and packaging is produced. Lastly, the absorbent paper product 106 having the options selected by the consumer is delivered to the consumer. (Spec. ¶23, Fig. 1A).

⁴ U.S. Pat. App. Pub. 2002/0082745 A1.

According to another aspect of the invention, a method of producing an absorbent paper product to order 200 that includes collecting information from a consumer 202 relating to one or more desired features of the absorbent paper product and its packaging. (Spec. ¶¶24-25, Fig. 2, Claim 41). Next, a purchase order is received from the consumer 204 for an absorbent paper product and packaging having the one or more desired features. (Spec. ¶25, Fig. 2). Then, the absorbent paper product and packaging 206 is produced having the one or more desired features in accordance with the information collected from the consumer. Lastly, the absorbent paper product having the options selected by the consumer is delivered to the consumer.

According to still another aspect of the invention, a system 400 is provided for producing an absorbent paper product based on information received from a consumer 402 over a communications network 404. (Spec. ¶27, Fig. 4, Claims 42-44). The information relates to one or more features of the absorbent paper product and its packaging desired by the consumer. A computer server acts as the network interface 406, connecting the communications network 404 to the production machine 408. The production machine 408 is configured to receive the information provided by the consumer over the network server 406 and to produce the absorbent paper product and its packaging 410 desired by the consumer based on said information. The production machine 408 may also include a printer 510 and/or fragrancener 512. (Spec. ¶29, Fig. 5, Claims 42 (printer), 43 (fragrancener)).

VI. Issue

The issue presented on appeal is as follows:

1. Whether claims 24-27, 33, 39, 41, 42 and 44-48 are unobvious under 35 U.S.C. §103 over Direct Marketing in view of Froseth and Schilling and whether claim 43 is unobvious in further view of Wilmott because the references fail to teach the customization of both a product and its packaging.

VII. Grouping of Claims

For the purposes of this Appeal, claims 24-27, 33, 39, 41-48 stand or fall together.

VIII. Argument

The burden of establishing a prima facie case of unpatentability lies with the Patent and Trademark Office.⁵ A prima facie case of nonobviousness is only established when the Office provides (i) one or more references (ii) available to the inventor (iii) that teach (iv) a suggestion to combine or modify the references, (v) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.⁶ The Office must explain why the prior art would "appear to show the *claimed subject matter*," and not simply the general aspects of the invention.⁷ If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled a grant of the patent.⁸

A. Direct Marketing in view of Froseth, Schilling and Wilmott does not teach selecting both a product design feature and packaging design graphic

The Federal Circuit has stated, "the test for obviousness is not whether the features of one reference may be bodily incorporated into another reference... Rather, we look to see whether combined teachings render the claimed subject matter obvious."⁹ Furthermore, prior art "references that teach away cannot serve to create a prima facie case of obviousness"¹⁰.

⁵ *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-39 (Fed. Cir. 1986).

⁶ See *In re Lintner*, 458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972); *In re Fielder*, 471 F.2d 640, 176 USPQ 300, 302 (C.C.P.A. 1973).

⁷ *In re Rhinehart*, 531 F.2d 1048, 189 USPQ 143, 147 (C.C.P.A. 1976).

⁸ *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

⁹ *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (C.C.P.A. 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (C.C.P.A. 1964)).

¹⁰ *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979).

1. The references fail to teach the customization of a product's packaging

The combination of references cited by the Examiner teach the customization of a product and fail to teach the customization of a product and the product's packaging as recited by the claims. In particular, the claims recite:

Claim 24: ... a plurality of custom tissues within a custom package for a consumer ...

receiving information ... relating to a first option ... of a tissue feature ... and relating to a second graphical option ... of a package feature ...;

providing said information to a production machine ...;

producing by the production machine the custom tissues in the package therefor as desired by the consumer ...

Claim 33: ... customizes an absorbent paper product and customizes a packaging for the absorbent paper product ...

receiving ... a first selected one of the first plurality of graphic designs of the absorbent paper product, ... a second selected one of the second plurality of graphic designs of the packaging ...

providing ... the first selected graphic design and ... second selected graphic design to a production machine ... said production machine configured to incorporate the first selected graphic design into the absorbent paper product and the second selected graphic design into the packaging ...

producing ... the custom absorbent paper product ... and having the packaging embodying the second selected graphic design ...

providing the custom absorbent paper product ... said consumer.

Claim 41: ... an absorbent paper product and a packaging therefor ...

collecting information ... relating to a desired product feature of the absorbent paper product ...

collecting information ... relating to a desired package feature of the packaging for the absorbent paper product ...

receiving a purchase order ...

producing the absorbent paper product having the identified one of the plurality of first options and with the packaging having the identified one of the plurality of second graphical options ...

providing to the consumer the produced absorbent paper product having the first option and with the packaging having the identified second graphical option in accordance with the information collected from the consumer.

Claim 42: A system ... for producing a custom absorbent paper product and a packaging therefor ...

a network interface accessible to the consumer for receiving information ... of a product feature ... and ... of a package feature ...

a production machine ... configured to receive the information ... said production machine configured to produce custom absorbent paper products ... and configured to produce packagings for the custom absorbent paper products ... wherein said production machine produces the custom absorbent paper product with the packaging as desired by the consumer and in accordance with said information ...

a computer server ... is configured to receive said information from the consumer via the communications network, and to provide said information to the production machine.

Claims 43-44: A system ... producing a custom absorbent paper product and a packaging therefor ...

a network interface accessible to the consumer for receiving information ... of a product feature ... and ... a package feature ...

a production machine ... wherein said production machine produces the custom absorbent paper product with the packaging as desired by the consumer and in accordance with said information ...

a computer server ... configured to receive said information from the consumer via the communications network, and to provide said information to the production machine.

Thus, each claim recites customizing a package feature. In contrast, the references cited by the Examiner disclose the customization of a product, not it's packaging. For example,

Froseth states that a method for "selecting, ordering and distributing customized food products is disclosed".¹¹ Furthermore, Froseth defines the term "customized food product" as a "food product that contains any type of customized food ingredients".¹² Wilmott discloses methods and systems for "producing a customized composition for at least one of topical, oral, nasal, anal, ophthalmic, and vaginal application".¹³ Direct Marketing mentions an ad for toilet paper with custom images.

Schilling states that his "disclosure relates to a process for printing customized images on packages in low order quantities".¹⁴ Thus, Schilling teaches that a low order quantity of packages with a customized image is produced instead of a single customized package for a customized product, as contemplated by the claims in issue. For example, Schilling notes that "Order quantities of 1000, 500, 100, or even less are not uncommon for small business."¹⁵ Schilling further discloses that the method specifically relates to receiving a customer order, translating the order into instructions for processing packaging materials, printing a quantity of packaging materials with the same customized image, and shipping the quantity of packaging materials to the customer.¹⁶ In other words, in Schilling, a low order quantity of packages is the customized product.

Significantly, Schilling discloses just another method to customize a product (e.g. the package) like the ones taught by Froseth (food), Wilmott (cosmetics and pharmaceuticals) and Direct Marketing (toilet paper). Therefore, in combination, Direct Marketing, Froseth, Wilmott, and Schilling only disclose a method to customize a product, while the claims recite methods and systems for customizing both a product and its packaging via a communication network. Because the combination of references fail to disclose the customization of a product's packaging, Appellant's claims are unobvious under 35 U.S.C. § 103 and should be allowed.

¹¹ U.S. Pat. App. Pub. 2002/0004749, ¶ 57.

¹² Id., ¶ 68.

¹³ U.S. Pat. App. Pub. 2002/0082745, ¶ 22.

¹⁴ U.S. Pat. App. Pub. 2003/0035138, ¶ 2.

¹⁵ Id. ¶ 4.

2. The teachings of Schilling are inconsistent with the other cited references

Even if Schilling is read to suggest a customized package, Schilling is inconsistent with the other references and thus, cannot be combined with the other references to create a prima facie case of obviousness. Direct Marketing and Wilmott fail to even mention anything about packaging. Thus, packaging is unimportant according to Direct Marketing and Wilmott as compared to customized packaging, as taught by the invention.

The Froseth reference teaches that the packaging features are dictated by the product, not the consumer's choice. For example, Froseth discloses that, "[t]he package is then weighed and labeled with relevant nutrition, ingredient and serving information."¹⁷ Additionally, Froseth teaches that this information is dictated by the product formulation; consequently, the package feature is not based on the consumer's choice as recited by the claims.¹⁸

On the other hand, if Schilling is read to suggest a customized package, the Schilling reference would be viewed as teaching that the features of a low order quantity of packages come from the choice of the customer. Since the process in Schilling relates to a low order quantity of packages which presumably would all receive the same product, it teaches away from bringing together a particular packaging feature and a particular product feature as recited by the claims.

Thus, the references are inconsistent with each other because Schilling teaches away from bringing together independent product and packaging features, while Froseth teaches that the packaging feature is dictated by the contents of the package, and while Direct Marketing and Wilmott fail to even mention anything about packaging.

In summary, the references cited by the Examiner are inconsistent with each other in respect to the customization of both packaging and product. In fact, the Examiner's rejection provides a textbook example of impermissible hindsight analysis -- the Examiner used the invention as defined by the claims as a guide to pick and choose elements from inconsistent

¹⁶ Id., ¶ 43 (emphasis added).

¹⁷ U.S. Pat. App. Pub. 2002/0004749, ¶ 100.

references in order to reject the claims.¹⁹ Therefore, the Examiner has failed to present a prima facie case of obviousness; thus, Appellant demands that the claims be allowed.

3. Froseth teaches away from the invention by disclosing that the product packaging design is dictated by the product's contents

Froseth teaches away from the claimed invention and therefore, cannot be combined with the other references to create a prima facie case of obviousness. Appellant claims methods and systems that allow the consumer to bring together a packaging feature and a product feature based on the consumer's aesthetic or arbitrary choices. On the other hand, the Froseth reference teaches that the packaging features are dictated by the product formulation, not the consumer's arbitrary or aesthetic choice.²⁰ Consequently, Froseth teaches away from the Appellant's claims in respect to the customization of the packaging; and thus, Froseth cannot be combined with other references to create a prima facie case of obviousness. Accordingly, Appellant demands that the claims be allowed.

B. Examiner failed to provide a motive to combine Direct Marketing, Froseth, Schilling and Wilmott

The Examiner has failed to provide a motive to combine Direct Marketing, Froseth, Schilling and Wilmott. A prima facie case of obviousness requires some reason, suggestion, or motivation from the prior art for the person of ordinary skill to have combined the references.²¹ Examiner's basis for the obviousness rejection is deficient because the product type was given

¹⁸ Id.

¹⁹ *In re Fine*, 837 F.2d 1071, 1074-1075 (Fed. Cir. 1988).

²⁰ U.S. Pat. App. Pub. 2002/0004749, ¶ 100.

²¹ See *In re Geiger*, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987) (citing *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPC 1961)), cert. denied, 469 U.S. 851 (1984): In concluding that obviousness was established by the teaching in various pairs of references, the district court lost sight of the principal that there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention before the court would have been obvious.

insufficient patentable weight, Official Notice was not taken of an Examiner's assertion, and no motive for combining the references was stated in the Office Action.

1. The product type in Appellant's claims is functional and was given insufficient patentable weight

The type of product being customized should be given patentable weight because it is functional and distinguishes Appellant's claims from the prior art. The Examiner's argument that the type of product is given little patentable weight is contrary to the plain language of the claims and unsupported. According to MPEP § 2116, "the materials on which a process is carried out must be accorded weight in determining the patentability of a process"²². In this case, Appellant's specification and claims disclose a process to customize a "plurality of tissues" or "absorbent paper products" and their packaging. Therefore, these "plurality of tissues" and "absorbent paper products" are acted upon by the process and should be given patentable weight.

Material may be deemed non-functional and descriptive if it does not alter how the process steps are to be performed to achieve the utility of the invention²³. However, a straightforward reading of the Appellant's claims recite that the systems and methods are dependent on the type of product. For example, the body of method claim 24 states "receiving information from the consumer via a communications network, said information relating to a first option of a first plurality of options of a tissue feature of the plurality of custom tissues". And system claim 42 states "a system ... for producing a custom absorbent paper product and a packaging therefor ... a network interface accessible to the consumer for receiving information ... of a product feature ... and ... of a package feature ..."

On the other hand, Froseth, for example, discloses a process to create a customized food product. Froseth makes a selection from a list consisting of customized food product choices,

²² MPEP § 2116, pg. 2100-57 (emphasis added) (citing *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974)).

²³ Chisum on Patents Chapter 1, § 1.03.

customized food ingredient choices, and customized food category choices.²⁴ Selections relating to food products, food ingredients, and food categories are different subject matter than tissue features and tissue package features. Therefore, the type or kind of products recited in the claims of the application are functional and distinguishes Appellant's claims from the prior art. The Examiner's argument that the type of product is non-functional is without merit and the type of product should be given appreciable patentable weight. Thus, when the claims are read to give patentable weight to the recitation of tissues (claim 24) and absorbent paper product (claims 33, 41, 42, 44), the claims are distinguishable over the combined reference and must be allowed.

2. The Examiner failed to cite a reference to establish that "the ability to shop online and customize a product..." was old and well known in the art

On page 9 of the Office Action mailed 1/29/04, the Examiner seems to suggest that part of the basis for the rejection is the Examiner's assertion that "the ability to shop online and customize a product by selecting several features was old and well known...." The Examiner cites MPEP 2144.03 regarding common knowledge or well-known art. However, contrary to MPEP 2144.03, the Examiner has failed to take Official Notice of this assertion. In addition, contrary to MPEP 2144.03, this assertion has not been stated as a basis for the rejection. The Examiner has stated only that the claims are rejected based on Direct Marketing, Froseth, Schilling and Wilmott. Thus, MPEP 2144.03 is not applicable.

Furthermore, Examiner argues that Appellant failed to "adequately traverse the official notice" of the Examiner's assertion and that it is now admitted prior art. However, as explained above, the Examiner failed to take Official Notice of this assertion. Additionally, Appellant disagrees that the assertion is admitted prior art and submits that the rejection was adequately traversed on pages 7-8 of Appellant's response dated 3/29/04. The Examiner has failed to cite a reference in support of this assertion and consequently, has not shown a motive to combine the non-analogous references.

²⁴ U.S. Pat. App. Pub. 2002/0004749, ¶ 119.

3. There is no motivation to combine Direct Marketing, Froseth, and Schilling to save consumer time and cost

Motivation to combine prior art may be based on the need or gains in convenience from the resulting combination, but not when the prior art is inconsistent or "teaches away" from the combination.²⁵ The Examiner on page 6 of the Office Action mailed 1/29/04 suggests that there is motivation to combine Direct Marketing, Froseth, and Schilling "to save consumer time and cost". However, the Examiner's contention is without merit because the Schilling reference teaches away from the Froseth reference.

The Froseth reference teaches that the packaging features are dictated by the product, not the consumer's arbitrary or aesthetic choice.²⁶ On the other hand, the Schilling reference teaches that the features of the product (i.e., the package) come from the consumer. Furthermore, since the process in Schilling relates to a quantity of products, it teaches away from bringing together a particular package feature and a particular product feature.²⁷ Thus, Froseth and Schilling teach away from each other because Schilling teaches only product features, while Froseth teaches that the packaging feature is dictated by the contents of the package. Consequently, the Examiner's reason for combining is unsubstantiated speculation which is contrary to the cited art. Thus, a prima facie case of obviousness has not been presented so that the claims should be allowed.

C. Schilling, Froseth and Wilmott are not analogous to the art of custom absorbent paper products and custom absorbent paper packaging

A prima facie case of obviousness requires that a cited reference is in an analogous art, and therefore available to the inventor. A reference is considered in an analogous art if it is

²⁵ *In re Oggero*, Civ. App. No. 99-1116, pg. 2 (Fed. Cir. Aug. 10 1999) (unpublished).

²⁶ U.S. Pat. App. Pub. 2002/0004749, ¶ 100.

²⁷ U.S. Pat. App. Pub. 2003/0035138, ¶ 54.

either "within the field of the inventor's endeavor" or "reasonably pertinent to the particular problem which the inventor is involved".²⁸

1. Schilling, Froseth and Wilmott are not within the inventor's field of endeavor, the manufacture of custom absorbent paper products and its packaging

Appellant's claims are directed to methods and systems that produce a custom absorbent paper product and its customized packaging. As such, the field of endeavor of the invention is the manufacture of customized absorbent paper products and its customized packaging. The Federal Circuit has defined fields of endeavor with a narrow view.²⁹

The specification of the Froseth reference states that the field of endeavor is "systems and methods for ordering and distributing food".³⁰ The specification of the Wilmott reference states that the field of endeavor is "a method and system for producing customized cosmetic and pharmaceutical formulations on demand".³¹ Neither reference relates to the methods and systems to produce a custom absorbent paper product and its customized packaging. In fact, neither reference states that the field of endeavor relates to the packaging of a product. Therefore, these references are not in the same field of endeavor as Appellant because they do not relate to the customization of the packaging of their products. Additionally, the Froseth reference comes from the food industry and Wilmott reference comes from the cosmetic and pharmaceutical industry, while Appellant is in the absorbent paper product industry. Thus, these references are not in Appellant's field of endeavor, the customized manufacture of absorbent paper products and its packaging.

²⁸ *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986).

²⁹ See e.g. *Wang Lab., Inc. v. Toshiba Corp.*, 993 F. 2d 858, 26 USPQ 2d 1787 (Fed. Cir. 1993) (compact modular memories are not in the same field as endeavor as memory circuits which modules of varying sizes may be added or replaced); *In re Huene*, Civ. App. No. 99-1514 (Fed. Cir. Aug. 11, 2000) (unpublished) (nonslip fastener torquing system in aerospace industry not in the same field as endeavor as nonslip fastener torquing system in medical industry).

³⁰ U.S. Pat. App. Pub. 2002/0004749, ¶ 6.

³¹ U.S. Pat. App. Pub. 2002/0082745, ¶ 1.

The specification of the Schilling reference states that it only relates to a process for printing customized images on products (i.e., the package) in relatively low order quantities.³² Thus, Schilling relates to a process used by manufacturers.³³ Therefore, Schilling is not in the same field of endeavor as Appellant, because the Appellant's field of endeavor includes the customization of the product's packaging as well as the customization of the absorbent paper product by a consumer. In conclusion, Schilling, Froseth and Wilmott references are outside of Appellant's field of endeavor.

2. Schilling, Froseth and Wilmott are not reasonably pertinent to the problem of allowing the consumer greater flexibility in her choice of absorbent paper products and packaging

In paragraph 2 of the specification, Appellant has disclosed that the invention is directed to the problem that while a wide variety of features are available for absorbent paper products exist and a wide variety of graphic designs for absorbent paper products packaging exist, "only a limited number of combinations" of features and packaging are available to the consumer. Consistent with this, the claims are directed to systems and methods in which consumers choose an absorbent paper product and its packaging. Thus, the Appellant is addressing the problem of providing the consumer with a customized package as well as a customized product.

Both the Wilmott and Froseth references are related to providing a customized product, but not customized packaging. In the Wilmott reference, the inventor states that his invention addresses the need in cosmetic and pharmaceutical industries to have customized formulations³⁴, while in the Froseth reference, the inventor states that his invention addresses the need for customized food products in the food industry³⁵. Wilmott and Froseth address the problem of allowing the user to select custom ingredients, not packaging for custom products.

³² U.S. Pat. App. Pub. 2003/0035138, ¶ 2.

³³ Id., ¶ 13.

³⁴ U.S. Pat. App. Pub. 2002/0082745, ¶ 5.

³⁵ U.S. Pat. App. Pub. 2002/0004749, ¶ 10.

Finally, the Schilling reference addresses the problem of providing a quantity of customized products (i.e., package) to a consumer. In the Schilling reference, the inventor states that he is addressing the cost of custom printing of a product (i.e., the package) in relatively low order quantities.³⁶ This reference does not refer to the problem of providing the consumer with the ability to coordinate the custom packaging with a customized product for aesthetic reasons; therefore, it does not address the same problem as Appellant.

In conclusion, because Schilling, Froseth and Wilmott cited by the Examiner are not within the field of the inventor's endeavor or reasonably pertinent to the particular problem that the inventor is involved, these references are not analogous art. Consequently, the Examiner has failed to present a prima facie case of obviousness and Appellant demands that the claims be allowed.

IX. Conclusion

The rejections of the claims on appeal are in error for the reasons set forth above. Therefore, appellant requests that the Examiner's rejections of claims 24-27, 33, 39 and 41-48 be reversed.

* Enclosed is a check in the amount of \$330.00 for the appeal brief fee under 37 CFR 1.17(c). Any additional fee may be charged to Deposit Account No. 19-1345.

Respectfully submitted,



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³⁶ U.S. Pat. App. Pub. 2003/0035138, ¶ 4.

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APPENDIX A

PENDING CLAIMS ON APPEAL

Claim 24. A method in which a manufacturer produces a plurality of custom tissues within a custom package for a consumer, the method comprising the manufacturer:

receiving information from the consumer via a communications network, said information relating to a first option of a first plurality of options of a tissue feature of the plurality of custom tissues and relating to a second graphical option of a second plurality of graphical options of a package feature of the package;

providing said information to a production machine linked to the communications network and configured to receive the information provided by the consumer via the communications network, said production machine configured to produce custom tissues including any one of the first plurality of options of the tissue feature and configured to produce custom packages including any one of the second plurality of options of the package feature; and

producing by the production machine the custom tissues in the package therefor as desired by the consumer and in accordance with the information received from the consumer such that the produced custom tissues have the first option and the produced package has the second graphical option.

Claim 25. The method of claim 24 wherein the communications network is a computer network, and wherein receiving includes receiving said information from the consumer over the computer network via a computer server.

Claim 26. The method of claim 24 wherein the communications network is a telephony network, and wherein receiving includes receiving said information from the consumer over the telephony network via a telephone attendant.

Claim 27. The method of claim 26 wherein said telephone attendant is an automated attendant.

Claim 33. A method in which a supplier customizes an absorbent paper product and customizes a packaging for the absorbent paper product for a consumer, the method comprising the supplier:

identifying a first plurality of different graphic designs of the absorbent paper product;

identifying a second plurality of different graphic designs of the packaging for the absorbent paper product;

receiving from the consumer via a communications network a first identification of a first selected one of the first plurality of graphic designs of the absorbent paper product, a second identification of a second selected one of the second plurality of graphic designs of the packaging and a purchase order for a custom absorbent paper product embodying the first selected graphic design and having packaging embodying the second selected graphic design;

providing said first identification of the first selected graphic design and said second identification of the second selected graphic design to a production machine coupled to the communications network and configured to receive said first identification and said second identification provided by the consumer via the communications network, said production machine configured to incorporate the first selected graphic design into the absorbent paper product and the second selected graphic design into the packaging for the absorbent paper product;

producing by the production machine the custom absorbent paper product ordered by the consumer embodying the first selected graphic design and having the packaging embodying the second selected graphic design; and

providing the custom absorbent paper product embodying the first selected graphic design and having the packaging embodying the second selected graphic design only to said consumer.

Claim 39. The method of claim 24 wherein the tissue feature is product graphic design and wherein the package feature product packaging graphic design.

Claim 41. A method in which a supplier provides to a consumer an absorbent paper product and a packaging therefor to order, the method comprising the supplier:

collecting information from the consumer through a telephony or computer communications network, the information relating to a desired product feature of the absorbent paper product wherein the desired product feature includes a plurality of first options and wherein the information collected from the consumer identifies one of the plurality of first options;

collecting information from the consumer through the communications network, the information relating to a desired package feature of the packaging for the absorbent paper product wherein the desired package feature includes a plurality of second graphical options, wherein the information collected from the consumer identifies one of the plurality of second graphical options;

receiving a purchase order from the consumer for the absorbent paper product with the packaging wherein the purchase order specifies the identified one of the plurality of first options and the identified one of the plurality of second graphical options;

producing the absorbent paper product having the identified one of the plurality of first options and with the packaging having the identified one of the plurality of second graphical options; and

providing to the consumer the produced absorbent paper product having the first option and with the packaging having the identified second graphical option in accordance with the information collected from the consumer.

Claim 42. A system for use with a communications network, said system being used by a supplier for producing a custom absorbent paper product and a packaging therefor desired by a consumer, said system comprising:

a network interface accessible to the consumer for receiving information from the consumer over the communications network, said information relating to a first option of a first plurality of first options of a product feature of the absorbent paper product desired by the consumer and a second graphical option of a second plurality of second graphical options of a package feature of the packaging for the absorbent paper product;

a production machine linked to the communications network and configured to receive the information provided by the consumer via the communications network, said production machine configured to produce custom absorbent paper products including any one of the first plurality of options of the product feature and configured to produce packagings for the custom absorbent paper products including any one of the second plurality of options of the package feature, wherein said production machine produces the custom absorbent paper product with the packaging as desired by the consumer and in accordance with said information such that the produced custom absorbent paper product includes the first option and the packaging for the produced custom absorbent paper product includes the second graphical option, the production machine including a printer for printing the graphic design on the absorbent paper product desired by the consumer or on the packaging for the absorbent paper product; and

a computer server operatively connected to the production machine and the communications network, wherein the computer server is configured to receive said information from the consumer via the communications network, and to provide said information to the production machine.

Claim 43. A system for use with a communications network, said system being used by a supplier for producing a custom absorbent paper product and a packaging therefor desired by a consumer, said system comprising:

a network interface accessible to the consumer for receiving information from the consumer over the communications network, said information relating to a first option of a first plurality of first options of a product feature of the absorbent paper product desired by the consumer and a second graphical option of a second plurality of second graphical options of a package feature of the packaging for the absorbent paper product;

a production machine linked to the communications network and configured to receive the information provided by the consumer via the communications network, said production machine configured to produce custom absorbent paper products including any one of the first plurality of options of the product feature and configured to produce packagings for the custom absorbent paper products including any one of the second plurality of options of the package feature, wherein said production machine produces the custom absorbent paper product with the

packaging as desired by the consumer and in accordance with said information such that the produced custom absorbent paper product includes the first option and the packaging for the produced custom absorbent paper product includes the second graphical option, said production machine including a fragrancier for applying the scent to the absorbent paper product desired by the consumer; and

a computer server operatively connected to the production machine and the communications network, wherein the computer server is configured to receive said information from the consumer via the communications network, and to provide said information to the production machine.

Claim 44. A system for use with a communications network, said system being used by a supplier for producing a custom absorbent paper product and a packaging therefor desired by a consumer, said system comprising:

a network interface accessible to the consumer for receiving information from the consumer over the communications network, said information relating to a first option of a first plurality of first options of a product feature of the absorbent paper product desired by the consumer and a second graphical option of a second plurality of second graphical options of a package feature of the packaging for the absorbent paper product, wherein the product feature is selected from product count, product style, product color, product scent and product graphic design and wherein the package feature is selected from product packaging style, product packaging color and product packaging graphic design;

a production machine linked to the communications network and configured to receive the information provided by the consumer via the communications network, said production machine configured to produce custom absorbent paper products including any one of the first plurality of options of the product feature and configured to produce packaging for the custom absorbent paper products including any one of the second plurality of options of the package feature, wherein said production machine produces the custom absorbent paper product with the packaging as desired by the consumer and in accordance with said information such that the produced custom absorbent paper product includes the first option and the packaging for the produced custom absorbent paper product includes the second graphical option; and

a computer server operatively connected to the production machine and the communications network, wherein the computer server is configured to receive said information from the consumer via the communications network, and to provide said information to the production machine.

Claim 45. The method of claim 41 wherein the product feature is product graphic design and wherein the package feature is packaging graphic design.

Claim 46. The method of claim 42 wherein the product feature is product graphic design and wherein the package feature is product packaging graphic design.

Claim 47. The method of claim 43 wherein the product feature is product graphic design and wherein the package feature is product packaging graphic design.

Claim 48. The method of claim 44 wherein the product feature is product graphic design and wherein the package feature is product packaging graphic design.